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In re Application of:	:	
COSFORD, Nicholas, David, Peter, et al.	:	DECISION ON PETITION
U.S. Application No.: 10/532,634	:	(37 CFR 1.181)
PCT No.: PCT/US2003/033613	:	
International Filing Date: 24 October 2003	:	
Priority Date: 24 October 2002	:	
Atty Docket No.: MS0013YP	:	
For: ALKYNE DERIVATIVES AS	:	
TRACERS FOR METABOTROPIC	:	
GLUTAMATE RECEPTOR	:	
BINDING	:	

This decision is issued in response to the "Communication In Response To Notification Of Missing Requirements" filed 17 January 2006, treated herein as a petition under 37 CFR 1.181 to confirm the previous filing of a fully executed declaration. No petition fee is required.

BACKGROUND

On 24 October 2003, applicants filed international application PCT/US2003/033613. The international application claimed a priority date of 24 October 2002, and it designated the United States. The published international application identifies six applicant/inventors for purposes of the United States: Nicholas David Peter COSFORD, Steven Patrick GOVEK, Terence Gerard HAMILL, Theodore KAMANECKA, Jeffrey Roger ROPPE, and Thomas Jonathon SEIDERS. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 25 April 2005 (24 April 2005 was a Sunday).

On 25 April 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and two copies of a five-page declaration document. Both of the declarations identified the six inventors listed on the international application, as well as five additional inventors: Celine BONNEFOUS, Matthew P. BRAUN, Dennis C. DEAN, Joseph Paul SIMEONE, and Donald BURNS. The filed declarations were only executed by two of the eleven inventors identified therein: Celine BONNEFOUS and Donald BURNS.

On 14 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that a properly executed oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing this declaration later than thirty months after the priority date were required. The Notification

indicated that the declarations filed 25 April 2005 were not acceptable because they were not executed in accordance with 37 CFR 1.66 or 1.68.

On 17 January 2006, applicants filed the correspondence considered herein as a petition under 37 CFR 1.181. The correspondence asserts that the original national stage materials filed 25 April 2005 included three copies of the declaration, and that all the inventors had executed these declarations.

DISCUSSION

As noted above, the application file contains only two copies of the five-page declaration filed 25 April 2005, and these declarations are executed by only two of the eleven inventors named thereon. The petition filed 17 January 2006 states that a third copy of the declaration was filed on 25 April 2005 (apparently executed by the nine remaining inventors), but this declaration is not present in the application file. The petition filed 17 January 2006 also states that copies of the three declarations filed 25 April 2005, and the postcard receipt confirming the earlier filing, are attached thereto, but no such attachments are present in the file (the only item filed 17 January 2006 that is present in the application file is the two-page letter entitled "Communication In Response To Notification Of Missing Requirements). Accordingly, because the application file does not contain a copy of the third declaration document or a copy of the return postcard receipt confirming the filing of such declaration on 25 April 2005, applicants' petition to confirm the filing of a fully executed declaration on 25 April 2005 cannot be granted on the present record.

Even if applicants can provide an adequate showing that completely executed versions of the declarations were filed on 25 April 2005, the declarations would not be acceptable because they do not properly identify the inventors herein. As noted above, the declaration filed 25 April 2005 includes five inventors who are not of record in the present application. A review of the international application file reveals that, on 04 April 2005, applicants filed a request in the international application seeking to add these inventors to the application. However, such a change in inventorship is only effective if entered by the International Bureau (IB) (see PCT Rule 92bis), and there is no indication that the requested addition of inventors was ever entered by the IB (for example, the international application file does not include a Form IB/306 confirming any change of inventorship, and the WIPO online bibliographic data for this file does not include these additional inventors).

Absent a showing that the addition of Celine BONNEFOUS, Matthew P. BRAUN, Dennis C. DEAN, Joseph Paul SIMEONE, and Donald BURNS as inventors herein was entered by the IB during the international phase, applicants must correct the inventorship of record herein before any declarations including these inventors can be accepted. The applicable regulation in such circumstances is 37 CFR 1.497(d), which requires applicants to submit: (1) a statement from each person being added or deleted as an inventor stating that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)).

CONCLUSION

The petition to under 37 CFR 1.181 to confirm the 25 April 2005 filing of a fully executed declaration is **DISMISSED** without prejudice.

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the mail date of this decision. Any such request should be entitled "Renewed Petition Under 37 CFR 1.181" and included an adequate showing that the executed declaration(s) was filed on 25 April 2005 (i.e., copies of the declarations, the stamped return postcard, and a statement confirming that the declarations supplied are true copies of those filed on 25 April 2005).

In addition, before the declarations filed 25 April 2005 can be accepted (even if fully executed), applicants must provide either: (1) a showing that Celine BONNEFOUS, Matthew P. BRAUN, Dennis C. DEAN, Joseph Paul SIMEONE, and Donald BURNS were added as inventors herein by the IB during the international phase (i.e., copies of the relevant Form(s) IB/306); or (2) a grantable request under 37 CFR 1.497(d) to add these inventors to the present application.

Failure to file a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this petition to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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